

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Schorr et al.

Application No.: 10/736,435

Filed: December 15, 2003

For: SYSTEM AND METHOD FOR
PROVIDING A DYNAMIC EXPANDED
TIMELINE

Confirmation No. 3420

Art Unit: 2628

EXAMINER: J. A. Amini

RESPONSE TO NOTIFICATION OF NON-COMPLIANT APPEAL BRIEF

MS Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In response to the Notification of Non-Compliant Appeal Brief dated May 13, 2008, appellant respectfully submits that the Appeal Brief is fully compliant with the requirements of 37 CFR § 41.37 and that appellant has the right to appeal the rejected claims at this time.

It is the Examiner's position that the Appeal Brief "does not specify the status of claims 25-26, 28, 30-34, 36-38, 40, and 42-43." Appellant respectfully disagrees. The Appeal Brief states the following: "Claims 23-44 are therefore presently pending. Claims 23-44 have been rejected." This clearly states the status of claims 25-26, 28, 30-34, 36-38, 40, and 42-43 as pending and rejected. Appellant is not aware of any requirement in Title 35 of the United States Code, Title 37 of the Code of Federal Regulations, or the Manual of Patent Examining Procedure that these claims must be indicated as "canceled" or "withdrawn," as maintained by the Examiner. Indeed, such

an indication would be incorrect since these claims have been neither canceled nor withdrawn.¹

It appears to be the Examiner's position that the filing of the notice of appeal was improper because "[c]laims 23-44 have not been rejected twice[]." Appellant respectfully submits that there is no requirement in Title 35 of the United States Code, Title 37 of the Code of Federal Regulations, or the Manual of Patent Examining Procedure that the presently pending claims be twice rejected for an appeal to be properly filed. 35 U.S.C. § 134 states:

(a) *Patent applicant.*—An applicant for a patent, any of whose claims has been twice rejected, may appeal from the decision of the primary examiner to the Board of Patent Appeals and Interferences having once paid the fee for such appeal.

(Emphasis added.) The Board of Patent Appeals and Interferences interprets the word "claims" in this Section to mean "claims for a patent," in a general sense, rather than particular "claims of an application." Ex parte Lemoine, 46 U.S.P.Q.2d 1420, 1423 (Bd. Pat. App. & Interf. 1994). Under this interpretation, "so long as the applicant has twice been denied a patent, an appeal may be filed." Id. at 1423.² The Examiner has rejected appellant's "claims for a patent" four times in the present application: four Office Actions have been issued by the Examiner, each rejecting appellant's "claims for a patent."³ Accordingly, appellant respectfully submits that an appeal was properly filed.

¹ The status of "withdrawn" refers to a claim that is not elected in response to a restriction requirement. Specifically, a withdrawn claim is a "[c]laim still in the application, but in nonelected status." ("Changes to Implement Electronic Maintenance of Official Patent Application Records," U.S.P.T.O. Official Gazette Notices, April 23, 2003.)

² In the answers to comments accompanying the final rule for 37 C.F.R. § 41.31(a)(1), the U.S.P.T.O. takes the following position:

The Board's precedential opinion in Ex parte Lemoine, 46 USPQ2d at 1423, interpreted the language of 35 U.S.C. 134 that gives applicants the statutory right to an administrative appeal to mean that "so long as the applicant has twice been denied a patent, an appeal may be filed." Thus, the alternative language of the proposed rule (i.e., "or finally (Sec. 1.113 of this title)") is not necessary.

("Rules of Practice Before the Board of Patent Appeals and Interferences," U.S.P.T.O. Official Gazette Notices, Sept. 7, 2004.) In the present application, since the claims have been finally rejected, an appeal is proper. (37 C.F.R. §1.113.)

³ The pending claims are clearly directed to the same overall subject matter as the now-canceled claims and were added to clarify the claimed subject matter of the now-canceled claims. Appellant could have

Appellant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 50-0665, under Order No. 418268833US from which the undersigned is authorized to draw.

Dated: June 13, 2008

Respectfully submitted,

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amended the now-canceled claims to recite exactly the same language as the newly added claims. If appellant had done so, the Examiner would not now be asserting that the appeal is improper. Thus, the Examiner's assertion with respect to the new claims is taking form over substance.